

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appellant:	Mulligan et al.	Examiner:	Doan, D.
Serial No.:	10/043,936	Group Art Unit:	2452
Filed:	January 11, 2002	Docket No.:	NOKM.015CIP
Confirmation No.:	9432	Customer No.:	76385
Title:	Network Services Broker System and Method		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being transmitted to the U.S. Patent and Trademark Office via the Office electronic filing system in accordance with 37 CFR 1.6(a)(4) on June 2, 2009.

By: /Rennae Johnson/
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**APPELLANT'S STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005 on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

Each of the prior art rejections (§§ 102(e) and 103(a)) relies upon the teachings of U.S. Patent No. 6,553,219 by Vilander *et al.* (hereinafter "Vilander"). Notably, each of the independent claims (Claims 1, 18, 30, 33, 34, 38, 39, and 41), except Claim 40, is rejected under § 102(e) solely in view of Vilander. Claims 1-6 and 8-33 are also rejected under § 112, second paragraph.

While Appellant has multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements required for *prima facie* anticipation and obviousness rejections. Although each of the independent claims is rejected in

the final Office Action (dated December 2, 2008), the Office Action has not shown that the asserted references teach or suggest each of the claimed limitations.

Specifically, the Office Action has not asserted, or presented, correspondence to several claim limitations of independent Claims 34, 38, and 39. For example, no teachings have been identified in Vilander that would correspond to providing a use authorization voucher to a visited network service broker associated with a visited network (*e.g.*, Claim 34); communicating between a home network service broker and a visited network service broker associated with a visited network, wherein the home network service broker serves as a proxy in accessing the service functionality available via the visited network (*e.g.*, Claim 38); and facilitating access by a service provision infrastructure to the service functionality available from a visited network via the loosely-coupled interface of the visited network service broker (*e.g.*, Claim 39). Without an assertion of correspondence to each of the claimed limitations, a *prima facie* § 102(e) rejection cannot be established.

With respect to the remaining independent claims (Claims 1, 18, 30, 33, 40, and 41), the example limitations at issue for purposes of this request for review relate to a network service broker comprising at least one terminal-coupled broker to communicate directly with one or more terminals, as claimed. To establish a *prima facie* § 102(e) or § 103(a) rejection of at least the independent claims, these limitations must be present in the asserted references, as the Examiner alleges.

The Examiner contends that the cited base stations 5 of Vilander may communicate directly with terminal 9; however, the base stations have not been shown to be a network service broker with a loosely-coupled interface exposed to a service provision infrastructure. Rather, the base stations are taught as only interfacing with a radio network controller. Also, a combination of Vilander's radio network controller with the base stations would not correspond to the claimed network service broker at least in that the radio network controller is a separate entity and does not comprise the base stations. Moreover, the base stations have not been shown to comprise a loosely-coupled interface, as claimed.

The multiple assertions that the claimed loosely-coupled interface inherently exists between Vilander's base stations and the access server in order for the two to communicate is unsupported and incorrect. First, no explanation or evidence has been provided in support of

such an assertion. Appellant notes that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Also, MPEP § 2112 states that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Second, while there may be an interface between the base stations and the access server, there is no suggestion that such an interface would be a loosely-coupled interface as claimed. Rather, the interface could be an Iub interface. Thus, the assertion of inherency is unsupported and fails to support a *prima facie* § 102(e) rejection.

With further respect to the § 103(a) rejections of Claims 3-5, 9, 10, 12-17, 23, 24, 26, and 40 based upon modifications of Vilander with the teachings of 2003/0013434 by Rosenberg *et al.* (hereinafter “Rosenberg”) and U.S. Publication No. 2002/0154642 by Hagirahim *et al.* (hereinafter “Hagirahim”), Appellant respectfully maintains the traversal. As discussed above, Vilander fails to correspond to several of the claimed limitations of the independent claims. The further reliance on Rosenberg and Hagirahim does not overcome the above-discussed deficiencies in Vilander at least because neither reference has been shown to teach or suggest a network service broker, as claimed. Thus, the asserted combinations of the teachings of Vilander with Rosenberg and Hagirahim do not teach each of the limitations of Claims 3-5, 9, 10, 12-17, 23, 24, 26, and 40 and the rejections should also be reversed.

Regarding the § 112, second paragraph, rejection, Appellant maintains that the claims clearly point out the claimed subject matter and that the Examiner’s interpretation is incorrect. The claims explicitly recite a first type of network system and a second type of network system; therefore, since the network systems are of different types they are not the same network system. However, both types of network systems could be included in the claimed plurality of network systems since the plurality is not limited to any specific type of network system. The claim language clearly distinguishes a first and second type of network system where both may be included in the claimed plurality of network systems. Thus, the Examiner’s interpretation of the

claimed first and second types of network systems being the same network system (at page four) is in contrast to the claim language and is incorrect. Appellant accordingly requests that the rejection be reversed.

It is respectfully submitted that there is an omission of an essential element needed to establish, *prima facie*, each of the rejections. Vilander does not teach or suggest at least a terminal-coupled broker. Because Vilander does not involve or otherwise address a network service broker comprising at least one terminal-coupled broker to communicate directly with one or more terminals, Appellant believes that the limitations directed to a terminal-coupled broker are improperly being overlooked. Consequently there is an omission of an essential element(s) required for at least the rejections based upon Vilander.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that the asserted rejections are improper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

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